

REMARKS

In response to the Office Action mailed July 28, 2003, Applicants respectfully request reconsideration. To further the prosecution of this Application, Applicants have amended claims, cancelled claims, and added claims. Further to this Amendment, claims 14-17, 56-59, 79-85, 102-105, and 132-179 are presented for examination. Claims 14, 16, 56, 59, 79, 83, 138, 146, 153, 160, 168 and 169 are in independent form.

Prior to considering this Amendment on the merits, Applicants respectfully request that the Examiner contact the undersigned attorney to schedule a telephone interview to discuss the changes to the claims that are presented herein. Applicants had attempted to schedule a telephone interview prior to filing this response, but the Examiner was unable to conduct an interview at that time due to his vacation schedule. He indicated, however, that he would be willing to conduct such an interview after an Amendment was filed.

In the Office Action, each of claims 1-137 was rejected under 35 U.S.C. § 103 as being unpatentable over U.S. Patent No. 6,282,656 (Wang) in view of U.S. Patent No. 6,012,636 (Smith). For the reasons stated below, each of the rejected claims that remains in this Application (i.e., claims 14-17, 56-59, 79-85, 102-105, and 132-137), and each of the new claims presented herein (i.e., claims 138-179) distinguishes patentably over the proposed combination of references.

A. Claims 14, 15, 102, and 103

Claim 14 is directed to an apparatus comprising a housing that supports at least one memory, a user authenticator, and at least one output. The at least one memory stores transaction information for at least one media. The user authenticator authenticates an identity of the user of the apparatus so as to enable release of an embedded identification code of the apparatus that is unique to the apparatus and that enables a device receiving the embedded identification code to authenticate the identity of the apparatus. The at least one output releases the embedded identification code of the apparatus from the housing after the user authenticator has authenticated the identity of the user.

Neither Wang nor Smith discloses or suggests the release of an embedded identification code of an apparatus that is unique to the apparatus and that enables a device receiving the embedded identification code to authenticate the identity of the apparatus.

In each reference, the device receiving information from a portable electronic device would be unable to authenticate the identity of the portable electronic device based upon the received information. In Wang, the released information includes only transaction approval data, and does not include any sort of embedded identification code that would enable the device receiving the code to authenticate the identity of the apparatus. In other words, the “requesting device” in Wang would be unable to determine whether the received information came from a particular portable electronic device. Instead, it would know only whether or not the transaction approval data had been received.

In Smith, the only information released from the portable electronic device is included on the first and second magnetic strips 12,14 (see Fig. 8A). Smith discloses that the first magnetic strip 12 stores data supplied by providers, and that the second magnetic strip stores a set of data unique to the card user (see col. 8, lines 11-22). It does not disclose or suggest the release of an embedded identification code that is unique to the apparatus and that enables the device receiving it to authenticate the identity of the apparatus.

Thus, the proposed combination of Wang and Smith does not disclose or suggest the invention recited in claim 14. The rejection should therefore be withdrawn.

Each of claims 15, 102 and 103, being dependent on claim 14, distinguishes patentably over the proposed combination of references for at least the same reasons.

B. Claims 16, 17, 104, and 105

Claim 16 is directed to a method comprising steps of storing transaction information for at least one media in a memory of a first device, and using the first device to authenticate an identity of a user. After the identity of the user has been authenticated with the first device, an embedded identification code is released from the first device that is unique to the first device and that enables a second device receiving the embedded identification code to authenticate the identity of the first device.

As discussed above in connection with claim 14, the proposed combination of Wang and Smith does not disclose or suggest the release of an embedded identification code that is unique to the device releasing it and that enables a second device that receives the code to authenticate the releasing device's identity.

Claim 16 therefore distinguishes patentably over the proposed combination of references, and the rejection based upon that combination should be withdrawn.

Each of claims 17, 104, and 105, being dependent on claim 16, distinguishes patentably over the proposed combination of references for at least the same reasons.

C. Claims 56-58, 132, and 133

Claim 56 is directed to an apparatus comprising a housing that supports a user authenticator, at least one memory, and at least one output. The user authenticator authenticates an identity of a user, and the at least one memory stores secure information identifying at least one account issued by at least one media, as well as non-secure information concerning the device's holder or issuer. The at least one output releases the secure information only after the user authenticator has authenticated the identity of the user, and releases the non-secure information without requiring the user authenticator to have authenticated the identity of the user.

Neither Wang nor Smith discloses or suggests an apparatus that permits secure information to be released from it only after user authentication, and that permits non-secure information concerning the device's holder or issuer to be released without requiring user authentication.

In Wang, the user authentication mechanism 612 is disclosed only as being an activation mechanism for the PEAD 200 (see col. 11, lines 5-13). It does not disclose or suggest that certain non-secure information could or should be released from the PEAD 200 without prior user authentication of the device.

Likewise, in Smith, a successful fingerprint scan is required in order to access any information stored in the device (see col. 10, lines 18-32).

Claim 56 therefore distinguishes patentably over the proposed combination of Wang and Smith, and the rejection based upon that combination should be withdrawn.

Each of claims 57, 58, 132, and 133, being dependent on claim 56, distinguishes patentably over the proposed combination of references for at least the same reasons.

D. Claims 59, 134, and 135

Claim 59 is directed to a method comprising a step of storing in at least one memory of a device secure information identifying at least one account issued by at least one media, as well as non-secure information concerning the device's holder or issuer. The device is used to authenticate an identity of its user, and the secure information is released only after the identity of the user has been authenticated. The non-secure information is released without requiring the identity of the user to have been authenticated.

As discussed above in connection with claim 56, the proposed combination of Wang and Smith does not disclose or suggest the release of non-secure information concerning a device's holder or issuer without requiring user authentication, in addition to the storage and release of secure information only following user authentication.

Claim 59 therefore distinguishes patentably over the proposed combination of references, and the rejection based upon that combination should be withdrawn.

Each of claims 134 and 135, being dependent on claim 59, distinguishes patentably over the proposed combination of references for at least the same reasons.

E. Claims 79-82, 178, and 179

Claim 79 is directed to a system comprising both a first device and a second device. The second device includes a user authenticator for authenticating the identity of a user, and has the first device releasably attached thereto such that, when the first device is attached to the second device and after the user authenticator has authenticated the identity of the user, the second device can cause the first device to embody a machine readable code after the first device is detached from the second device. The second device includes at least one controller configured so as to be capable, during only a predetermined, finite window of time, of causing the first device to embody the machine readable code. The beginning and ending points of the finite window of time are determined without regard to when the first device is attached to the second device.

The proposed combination of Wang and Smith does not disclose or suggest a controller that is configured so as to be capable, during only a predetermined, finite window of time, of causing a releasable device to embody a machine readable code.

Wang teaches nothing relevant to the claimed subject matter. As for Smith, the reference contains no disclosure or suggestion that its controller could or should be capable, during only a predetermined, finite window of time (having beginning and ending points that are determined without regard to when the card is attached to the device), of causing the released card to embody a machine readable code.

Claim 79 therefore distinguishes patentably over the proposed combination of references, and the rejection based on that combination should be withdrawn.

Each of claims 80-82, 178, and 179, being dependent on claim 79, distinguishes patentably over the proposed combination of references for at least the same reasons.

F. Claims 83-85, 136, and 137

Claim 83 is directed to a method comprising a step of configuring a first device such that the first device is capable during only a predetermined finite window of time of causing a second device, which is separable from the first device, to generate a machine readable code.

As discussed above in connection with claim 79, the proposed combination of Wang and Smith does not disclose or suggest the configuring of a first device such that it is capable of causing a second device to generate a machine readable code during only a predetermined, finite window of time (having beginning and ending points that are determined without regard to when the second device is attached to the first).

Claim 83 therefore distinguishes patentably over the proposed combination of references, and the rejection based upon that combination should be withdrawn.

Each of claims 84, 85, 136, and 137, being dependent on claim 83, distinguishes patentably over the proposed combination of references for at least the same reasons.

G. New Claims 138-145, 170, and 171

Claim 138 is directed to a method in which at least first account information for a first media issued by a first media issuer and second account information for a second media issued

by a second media issuer is stored in a database so that the first account information and the second account information exist simultaneously in the database. A communication link is established between a controller associated with the database and a portable electronic device distinct and remotely located from the database, and at least the first account information and the second account information is transferred from the database to a memory of the portable electronic device via the communication link so that at least the first account information and the second account information are caused to exist simultaneously in the memory of the portable electronic device. As recited in the remaining method steps, the portable electronic device is also transported to first and second point-of-sale terminals where it is used to engage in first and second transactions using the first media and second media, respectively.

The proposed combination of Wang and Smith does not disclose or suggest that first and second pieces of information could or should be stored in a database remote from a portable electronic device, and subsequently transferred to the portable electronic device for use in point-of-sale transactions. Wang contains no disclosure pertinent to the claimed subject matter. As for Smith, it teaches that cards are inserted into the device, one at a time, to load data from each card into the device's memory. It does not disclose or suggest the storage of any account information in a database separate from the portable electronic device, or the transfer of such information from a database to the portable electronic device.

Claim 138 therefore distinguishes patentably over the proposed combination of Wang and Smith, and should be in allowable condition.

Each of claims 139-145, 170, and 171, being dependent on claim 138, distinguishes patentably over the proposed combination of references for at least the same reasons.

H. New Claims 146-152, 172, and 173

Claim 146 is directed to a method comprising a step of storing a first version of information including at least first account information for a first media issued by a first media issuer and second account information for a second media issued by a second media issuer in a memory of a portable electronic device so that at least the first account information and the second account information exist simultaneously in the memory. A second version of information including at least the first account information and the second account information is

stored in a database distinct and remotely located from the portable electronic device so that at least the first account information and the second account information exist simultaneously in the database. The portable electronic device is transported to the vicinity of first and second point-of-sale terminals, and is used to engage in transactions at those terminals using the first and second media. After one of the first version of information and the second version of information has been altered, a communication link is established between a controller associated with the database and the portable electronic device. Commands are communicated between the controller and the portable electronic device that cause the alteration in the one of the first version of information and the second version of information to be reflected in the other.

The proposed combination of Wang and Smith does not disclose or suggest the storing of first and second versions of information, as claimed, or the altering of one of such first and second versions of information to reflect changes in the other.

New claim 146 therefore distinguishes patentably over the proposed combination of references, and should be in allowable condition.

Each of claims 147-152, 172, and 173, being dependent on claim 146, distinguishes patentably over the proposed combination of references for at least the same reasons.

I. New Claims 153-159, 174, and 175

Claim 153 is directed to a system comprising a network server and a portable electronic device. The network server comprises a database and a database controller associated therewith. The database has stored therein at least first account information for a first media issued by a first media issuer and second account information for a second media issued by a second media issuer. The portable electronic device is distinct and remotely located from the network server. It comprises a device controller, a memory, a user input device, and an output. The device controller is configured to establish a communication link with the network server and to enable the transfer of at least the first account information and the second account information from the database to the memory of the portable electronic device via the communication link. The device controller is further configured to select one of the first media and the second media for use in a transaction at a point-of-sale (POS) terminal in response to manipulation of the user input device and to cause the output of the portable electronic device to release to the POS

terminal at least a portion of the one of the first account information and the second account information that corresponds to the selected one of the first media and the second media.

As discussed above in connection with claim 138, the proposed combination of Wang and Smith does not disclose or suggest the storage of first account information and second account information in a database that is distinct and remotely located from a portable electronic device, or the transfer of such account information from a database to such a portable electronic device.

Claim 153 therefore distinguishes patentably over the proposed combination of references, and should be in allowable condition.

Each of claims 154-159, 174, and 175, being dependent on claim 153, should be allowable for at least the same reasons.

J. New Claims 160-167, 176, and 177

Claim 160 is directed to a system comprising a network server and a portable electronic device. The network server comprises a database and a database controller associated therewith. The database has stored therein a first version of information including at least first account information for a first media issued by a first media issuer and second account information for a second media issued by a second media issuer. The portable electronic device is distinct and remotely located from the network server, and comprises a device controller, a memory, a user input device, and an output. The memory has stored therein a second version of information including at least the first account information and the second account information. The device controller is configured to establish a communication link with the network server and to enable the communication of commands between the database controller and the device controller that cause alterations in one of the first version of information and the second version of information to be reflected in the other. The device controller is further configured to select one of the first media and the second media for use in the transaction at a point-of-sale (POS) terminal in response to manipulation of the user input device, and to cause the output of the portable electronic device to release to the POS terminal at least a portion of the one of the first account information and the second account information that corresponds to the selected one of the first media and the second media.

As discussed above in connection with claim 146, the proposed combination of Wang and Smith does not disclose or suggest a database, distinct and remotely located from a portable electronic device, that stores a first version of information that is different than a second version of information stored in a memory the portable electronic device, or the alteration of one of the first version of information and the second version of information to reflect the changes in the other.

Claim 160 therefore distinguishes patentably of the proposed combination of Wang and Smith, and should be in allowable condition.

Each of claims 161-167, 176, and 177, being dependent on claim 160, distinguishes patentably over the proposed combination of references for at least the same reasons.

K. New Claim 168

Claim 168 is directed to a system comprising a database having stored therein at least first account information for a first media issued by a first media issuer and second account information for a second media issued by a second media issuer. The system further comprises means for establishing a communication link between a controller associated with the database and a portable electronic device distinct and remotely located from the database, and for transferring at least the first account information and the second account information from the database to a memory of the portable electronic device via the communication link so that at least the first account information and the second account information are caused to exist simultaneously in the memory of the portable electronic device. The system further comprises means for selecting one of the first media and the second media for use in a transaction at a point-of-sale (POS) terminal, and means for releasing to the POS terminal at least a portion of one of the first account information and the second account information that corresponds to the selected one of the first media and the second media so as to authorize the transaction.

As discussed above in connection with claim 138, the proposed combination of Wang and Smith does not disclose or suggest the storage of first account information and second account information in a database distinct and remotely located from a portable electronic device, or the transfer of such information from a database to a memory of the portable electronic device.

Claim 168 therefore distinguishes patentably over the proposed combination of Wang and Smith, and should be in allowable condition.

L. New Claim 169

Claim 169 is directed to a system comprising a portable electronic device and a database. The portable electronic device comprises a memory having stored therein a first version of information including at least first account information for a first media issued by a first media issuer and second account information for a second media issued by a second media issuer. The portable electronic device further comprises means for selecting one of the first media and the second media for use in a transaction at a point-of-sale (POS) terminal, and means for releasing at least a portion of one of the first account information and the second account information that corresponds to the selected one of the first media and the second media from the portable electronic device to the POS terminal so as to authorize the transaction. The database is distinct and remotely located from the portable electronic device, and has stored therein a second version of information including at least the first account information and the second account information. The system further comprises means for establishing a communication link between a controller associated with the database and the portable electronic device, and for causing alterations in one of the first version of information and the second version of information to be reflected in the other.

As discussed above in connection with claim 146, the proposed combination of Wang and Smith does not disclose or suggest the storing of first and second versions of information in a database and a portable electronic device distinct and remotely located from the database, respectively, or the causing of alterations in one of the first version of information and the second version of information to be reflected in the other.

Claim 169 therefore distinguishes patentably over the proposed combination of Wang and Smith, and should be in allowable condition.

Serial No.: 09/675,438
Conf. No.: 9912

- 29 -

Art Unit: 3621

If this response is not considered timely filed and if a request for an extension of time is otherwise absent, Applicants hereby request any necessary extension of time. If there is a fee occasioned by this response, including an extension fee, that is not covered by an enclosed check, please charge any deficiency to Deposit Account No. 23/2825.

Respectfully submitted,
Todd O. Burger, et al.

By: 

Robert M. Abrahamsen, Reg. No. 40,886
Wolf, Greenfield & Sacks, P.C.
600 Atlantic Avenue
Boston, Massachusetts 02210-2211
Telephone: (617) 720-3500

Docket No. C1068.70005US00
Date: December 29, 2003
xx12/29/03xx